

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

SYMBOL TECHNOLOGIES, INC.,       )  
  )  
      Plaintiff,                       )  
  )  
      v.                                ) Civil Action No. 01-801-SLR  
  )  
PROXIM INCORPORATED,                )  
  )  
      Defendant.                      )

**MEMORANDUM ORDER**

At Wilmington this 25th day of June, 2002, having reviewed plaintiff's motion to dismiss and the papers filed in connection therewith;

IT IS ORDERED that said motion (D.I. 20) is granted in part and denied in part, for the reasons that follow:

1. Plaintiff moves to dismiss defendant's sixth, seventh and eighth counterclaims and to strike defendant's tenth affirmative defense. It is plaintiff's burden to prove that, accepting as true all of the facts alleged in the claims at issue, and drawing all reasonable inferences in defendant's favor, no relief could be granted as a matter of law. See Trump Hotels & Casino Resorts, Inc. v. Mirage Resorts, Inc., 140 F.3d 478, 483 (3d Cir. 1998).

2. **Defendant's sixth counterclaim**, claiming "false marking" pursuant to 35 U.S.C. § 292,<sup>1</sup> is based on defendant's allegation that plaintiff marked its 802.11b wireless network cards as being covered by two patents (not the patents at issue) when the cards were not covered by these patents or by the patents asserted against defendant in this lawsuit. Assuming for

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<sup>1</sup>Section 292(a) provides as follows:

Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of . . . deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United States by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the work "patent" or any word or number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public - -

Shall be fined not more than \$500 for every such offense.

35 U.S.C. § 292(a).

purposes of this motion that defendant's factual assertions are correct, plaintiff argues in response that the label it attaches to the circuit board inside of the sealed housing of some of its IEEE 802.11b PC cards is not the kind of act prohibited by § 292 because the offending labels are not visible to the public and, therefore, are not "markings" at all. The court agrees. Unlike the kind of public notice addressed by § 287, which requires that a patentee give notice to potential infringers in order to recover damages (i.e., it serves to protect potential infringers), the purpose of § 292 is to protect patentees from the fraudulent use of their name and devices and to protect the general public from false representations that articles are patented when they are not. Given that the only possible application of § 292 to a patentee is with respect to falsely marking an unpatented article for the purpose of deceiving the public, clearly a finding of intent to deceive the public is an essential element of the offense of mismarking. See Arcadia Machine & Tool Inc. v. Sturm, Ruger & Co., Inc., 786 F.2d 1124, 1125 (Fed. Cir. 1986). The court finds, as a matter of law, that the essential element of public deception cannot be demonstrated when the alleged mismarking is not apparent to the general public. The fact that competitors discovered the markings after taking apart the product simply is not the kind of conduct meant to be protected under § 292.

3. **Defendant's seventh counterclaim** for Lanham Act unfair competition is based on plaintiff's statements indicating that plaintiff believed that defendant's products infringed plaintiff's patent, and that plaintiff would obtain an injunction against defendant's products, especially its non-802.11 products. The court declines to dismiss this counterclaim based on the record presented. Although a patentee has the right to inform the public of its patent rights, the record indicates at this juncture that plaintiff did not merely restate the allegations made in the complaint at bar, but broadened its allegations of wrongdoing well outside the scope of this litigation. Unlike the circumstances in Moore N. Am., Inc. v. Poser Bus. Forms, Inc., No. 97-712-SLR, 2000 WL 1480992 (D. Del. Sept. 29, 2000), the court is not examining a summary judgment record, but an allegation that must be accepted as true. Patentees have the right to communicate, but do not have the right to communicate falsely. The court will allow the record to be fully developed in this regard.

4. **Defendant's eighth counterclaim**, alleging unfair competition and tortious interference by virtue of the conduct discussed above, shall not be dismissed at this juncture, the court finding that the requirements of notice pleading have been adequately met.

5. **Defendant's tenth affirmative defense**, based on plaintiff's false marking, is dismissed for the same reasons as stated above in connection with defendant's sixth counterclaim.

Sue L. Robinson  
United States District Judge